

## **REMARKS**

This is a full and timely response to the Decision on Appeal mailed June 12, 2007. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(e)**

#### **A. Rejection of Claims 1, 6, 9, 13, and 21-23**

The rejections of claims 1, 6, 9, 13, and 21-23 under 35 U.S.C. § 102(e) as being anticipated by *Kuwata, et al.* ("Kuwata," U.S. Pub. No. 2003/0072031) have been affirmed by the Board.

As indicated above, Applicant has amended independent claim 1 from which the other rejected claims depend. In view of that amendment, Applicant submits that the rejections are moot as having been drawn against Applicant's claims in a previous form.

Regarding the merits of claim 1, Applicant first notes that Kuwata at least fails to teach an "independent scanner" receiving a "request to initiate scanning of a document from a user network browser . . . having been sent directly to the independent scanner over a network". As previously mentioned, Kuwata teaches a scanner that is coupled to a server that receives network communications. See *Kuwata*, Figure 3. Therefore, Kuwata teaches no "independent scanner" that receives a request "having been sent directly to the independent scanner over a network".

Second, as also previously indicated, Kuwata in every embodiment in which scanning is described only teaches walk-up use of a scanner. No disclosure is

provided as to sending a request to scan via a network. Moreover, sending of such a request over a network is not "inherent" in Kuwata's disclosure. On that issue Applicant notes that just because a previously-scanned document can be accessed via a network in Kuwata's system does not necessarily mean that scanning can be initiated with a request sent over a network. Indeed, it appears clear that scanning is not initiated in that manner in Kuwata's system given that Kuwata describes, in every embodiment, that scanning is initiated by a user standing before the scanner. Applicant further notes just because it may have been possible to configure Kuwata's system to initiate scanning by sending a request over a network does not mean that such functionality is inherent. As described by the Federal Circuit:

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

*Scaltech Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 51 USPQ2d 1055 (Fed. Cir. 1999), Revising, 156 F.3d 1193, 48 USPQ2d 1037 (Fed. Cir. 1998). Furthermore, the Federal Circuit has noted:

Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.

*Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 51 USPQ2d 1943 (Fed. Cir. 1999) (emphasis added). Moreover, the Federal Circuit has stated:

[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that characteristic is necessarily present, or inherent, in the single anticipating reference.

*Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). As described above, Kuwata's system does not "necessarily function" as claimed by Applicant and sending of a request to scan is not "necessarily present" in Kuwata's system. Indeed, to the contrary, it is clear that Kuwata's system is always used in an alternative manner (i.e., walk-up use).

Third, Kuwata does not teach "an embedded server stored within memory contained within the independent scanner" uploading content to the user network browser over via network. Again, Kuwata teaches a scanner that relies on a separate server to receive and transmit over a network. *See Kuwata*, Figure 3.

#### **B. Rejection of Claim 17**

Claim 17 has been rejected by the Board under 35 U.S.C. § 102(e) as being anticipated by *James, et al.* ("James," U.S. Pat. No. 6,742,161).

As indicated above, Applicant has amended independent claim 17 through this Response. In view of that amendment, Applicant submits that the rejection is moot as having been drawn against Applicant's claim in a previous form.

Regarding the merits of claim 17, Applicant notes that James at least fails to teach an independent scanner comprising memory "provided within the independent scanner" that stores "an optical character recognition module" or "logic for generating at least one control screen that can be uploaded to a user network browser". Specifically, James

only shows a computer separate from a scanner that performs such functions. Furthermore, James at least fails to teach "the memory of the independent scanner further storing an embedded server that is configured to serve the at least one control screen to the user network browser via a network". Specifically, no server functionality is taught by James residing on an independent scanner.

## **II. Claim Rejections – 35 U.S.C. § 103(a)**

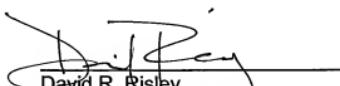
The rejections of claims 7, 8, 12, and 16 under 35 U.S.C. § 103(a) as being anticipated by *Kuwata* in view of *Dance, et al.* ("Dance," U.S. Pub. No. 2002/0076111) have been affirmed by the Board.

As indicated above, Applicant has amended independent claim 1 from which the rejected claims depend. In view of that amendment, Applicant submits that the rejections are moot as having been drawn against Applicant's claims in a previous form.

**CONCLUSION**

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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